

### REMARKS

Applicant has carefully reviewed and considered the Office Action mailed on March 16, 2004, and the references cited therewith.

Claims 1-3, 5-7, 9-12, and 18 have been amended, claims 19-24 have been added and claims 8 and 16 have been canceled. Thus, claims 1-7, 9-15, and 17-24 are now pending in this application.

#### §102 Rejection of the Claims

Claims 1-5, 7-15, 17 and 18 were rejected under 35 USC § 102(e) as being anticipated by Gomez et al. (U.S. Publication Number 2002/0160826, hereinafter referred to as Gomez). Applicant respectfully traverses this rejection because Gomez does not anticipate the claimed invention, as set forth in the amended claims.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ 2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim*.” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

The Office Action states, “Should Applicant wish to distinguish over Gomez, Applicant should further limit the claims to describe the outcomes described in the present application.” Following the Examiner’s suggestion, Applicant has amended independent claim 1 to recite such outcomes. In particular, amended independent claim 1 recites “in response to the first signal, generating the one of the plurality of display indicia on the display and emitting a second signal from one of the plurality of emitters, wherein the one of the plurality of display indicia is selected from the plurality of display indicia based on which of the plurality of sensors detects the first signal.” (Emphasis added to show newly added limitations.) Therefore, Applicant respectfully submits that independent claim 1 has been amended as suggested by the Examiner.

Additionally, Applicant respectfully submits that amended independent claim 1 is patentable over the cited prior art.

Claims 2-5, and 7 depend directly or indirectly on amended independent claim 1. Applicant respectfully submits that these dependent claims are allowable for the reasons discussed above, plus the elements of the claims. As noted above, claim 8 has been canceled.

Amended independent claim 9 recites “detecting the first light signal at a light sensor on a second of the machines adjacent to the first of the machines.” In contrast, Gomez describes a method and apparatus for physically networking Bonus Game Units of a plurality of gaming machines. In particular, Gomez teaches networking the gaming machines using the following techniques:

“All of the Bonus Game Units 18a, 18b, through 18n of Fig.2 are on a local area network via a LAN control 45 using a 10 Base T Ethernet network and hub. Any other suitable networking arrangement could be used, such as USB, RS-422, serial daisy-chain, IEEE-1394 and the like, as well as a standard casino online system (sometimes referred to as a player tracking system).”

Gomez Par. 28.

As such, the networking described in Gomez refers to physical connections (i.e. IEEE-1394 and other wired connections) for sharing data between the plurality of Bonus Game controllers. Moreover, Gomez teaches transmitting a signal over a physical network (e.g., Ethernet) to a plurality of controllers. See Gomez Par. 12, Lines 6-10. However, Gomez does not teach the claimed light emitter, which emits a light pulse to a light sensor on another gaming machine. For the reasons noted above, Applicant respectfully submits that amended independent claim 9 is patentable over the cited prior art.

Claims 10-15, 17, and 18 depend directly or indirectly on amended independent claim 9. Applicant respectfully submits that these dependent claims are allowable for the reasons discussed above, plus the elements of the claims.

§103 Rejection of the Claims

Claims 6 and 16 were rejected under 35 USC § 103(a) as being unpatentable over Gomez as applied to claims 1 or 11 above, and in further view of Pease et al. (U.S. Patent Number 5,759,102). Applicant respectfully traverses this rejection because the Office Action has not established a *prima facie* case of obviousness regarding the claims.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). To do that the Examiner must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *Id.*

The *Fine* court stated that:

Obviousness is tested by "what the combined teaching of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 878 (CCPA 1981)). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *ACS Hosp. Sys.*, 732 F.2d at 1577, 221 USPQ at 933. And "teachings of references can be combined *only* if there is some suggestion or incentive to do so." *Id.* (emphasis in original).

The M.P.E.P. adopts this line of reasoning, stating that

In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the

prior art, and not based on applicant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

Applicant respectfully submits that there is no suggestion to combine Pease and Gomez. The Office Action states "It would have been obvious to one of ordinary skill in the art to have used the teachings of Pease to implement an infrared network (with light signals emitted by a light source and detected by photo sensors) connecting gaming machines as described in Gomez in order to increase the flexibility of the network's physical layout." Applicant respectfully traverses this argument because Applicant knows of no passage in Gomez suggesting the need to increase the flexibility of the network's physical layout.

Moreover, even if there were a suggestion to combine Gomez and Pease, Applicant respectfully submits that the combination does not teach or suggest all the limitations of claim 6. Dependent claim 6 includes all the limitations of amended independent claim 1. Gomez does not teach light signals emitted by a plurality of light emitters, nor does it teach a plurality of light sensors. Therefore, in order for the combination to teach or suggest all the limitations of rejected claim 6, Pease would have to teach light signals emitted by a plurality of light emitters, and a plurality of light sensors. However, Pease teaches a "radio infrared". The Office Action does not describe "radio infrared" and there is no passage in Pease that describes it. Based on Pease, "radio infrared" does not include light signals emitted by a plurality of light emitters, nor does it include a plurality of light sensors. As such, Applicant respectfully submits that the combination of Gomez and Pease does not teach or suggest all the limitations of rejected claim 6. As noted above, Claim 16 has been canceled.

#### Reservation of Rights

Applicant does not admit that references cited under 35 U.S.C. §§ 102(a), 102(e), 103/102(a), or 103/102(e) are prior art, and reserves the right to swear behind them at a later date. Arguments presented to distinguish such references should not be construed as admissions that the references are prior art.

Conclusion

Based on the foregoing, Applicant respectfully requests that the rejections be withdrawn. Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612) 371-2169 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 30 day of April 2004.

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